

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (a) the inventions must be independent or distinct as claimed; and
- (b) there must be a serious burden on the examiner if restriction is required. *Id.*

The Examiner alleges that the inventions of Groups I and II have separate utility such as the inventions of Group I ability to be used as furniture for an office. Applicant respectfully submits that the Examiner has not properly established distinctness to support a basis for restriction.

The Examiner has not established any basis, and there is no limitation present in the claims, to support the assertion that the inventions in Group I can be used separately as office furniture while the inventions in Group II could not. Both groups of inventions include structural portions ("modules" in Group I; and "enclosure(s)" in Group II) that facilitate computer equipment and exercise equipment and both groups of inventions could be used as office furniture. Consequently, the Examiner has not shown that one of the invention groups has "utility other than in the disclosed combination," MPEP 806.5(d).

It is further submitted that the inventions in Group I and Group II would not used together in a single combination (and thus 806.05(d) is inapplicable) as alleged by the Examiner, because, e.g., the modules of Group I would be redundant of the enclosures of Group II in any such combination). Accordingly, the Examiner must demonstrate two-way distinctiveness and such has not been established. (e.g., Combination and subcombination; MPEP 806.05(c)).

For the foregoing reasons, Applicant submits that the Restriction Requirement of Groups I and II is improper and respectfully requests the Examiner to reconsider and withdraw the same.

B. RESTRICTION OF SPECIES.

The Examiner further alleges the application further contains claims directed to a plurality of disclosed and "patentably distinct" species as follows:

- Species I: Figs. 1, 2 and 9-12;
- Species II: Fig. 3;
- Species III: Figs. 4 and 5;

Species IV: Figs. 6 and 7;

Species V: Fig. 8;

Species VI: Fig. 9¹;

Species VII: Fig. 10;

Species VIII: Figs. 13-14.

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However, the Examiner has not provided any indication, and Applicant is unsure, of the features that the Examiner believes renders the cited figures as containing patentably distinct species. Consequently, Applicant is unable to make an informed election of claims based on the options presented by the Examiner. For example, Figs. 13 and 14 (Species VIII) illustrate the treadmill 214 shown with all the other alleged species in Figs. 2, 3, 5, 7 and 10, while Figs. 11 and 12 (Species I) illustrate the bench 202 and corresponding enclosure 104 shown with all of the other alleged species in Figs. 2, 3, 5, 7 and 9. Moreover, Fig. 8 illustrates a detailed example of enclosure 104 depicted in all of Figs. 1-7 and 11-12. Since items 214, 204 and 104 are reflected in all the Figures and only one type of each item is shown and described in the application, there are no several species shown and consequently no way for Applicant to differentiate claims related to Species V-VIII as opposed to Species I-V. Claims to be restricted to different species must be mutually exclusive. (See MPEP 806.04(e)-(f)).

Notwithstanding, if acceptable to the Examiner², Applicant identifies the following species of systems that are believed to be potentially shown in the application figures as follows:

Species 1: Figs. 1 & 2 a system having two exercise modules (e.g., a treadmill and a weight bench) and a bookcase or other third module formed in a straight line;

Species 2: Fig. 3 including a system having more than three modules formed in a "U" shape including two exercise modules (e.g., a treadmill and a weight bench);

Species 3: Figs. 4 and 5 including a system having multiple modules including two exercise modules (e.g., a treadmill and a weight bench) and a work surface; and

Species 4: Figs. 6 and 7 including a system having two exercise modules (e.g., a treadmill and a weight bench) in a back-to-back position and a work surface.

¹ This figure is also referenced by the Examiner as part of Species I.

² If the Applicant-identified species are not acceptable to the Examiner, the Examiner is requested to issue another restriction requirement clarifying the patentable differences between each species so that Applicant may make an informed election. MPEP 814

From these descriptions, Applicant identifies the following claims as readable on Applicant-identified Species 1-4:

Claims 1, 2, 3, 5, 6, 7, 8, 9, 10, 11, 14, 15, 16, 17, 18 and 19 are generic to all Applicant-identified species;

Claims 4 and 12 are directed to Species 3; and

Claim 13 is directed to Species 4.

1. Election of Species 3 with Traverse.

Applicant hereby elects species 3, directed to claims 1-12 and 14-19, with traverse.

2. Arguments Traversing Species Restriction.

“Every requirement to restrict has two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claims are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.” (MPEP 808, 816). In the Office Action mailed on June 27, 2002, the Examiner did not provide any reasoning or even a conclusory statement why the identified species are either independent or distinct; nor has the Examiner demonstrated why examining the limited number of species would present a serious burden. It is respectfully submitted that since there is only one non-elected claim, there would be no “serious burden” on the Examiner to examine all of Applicant’s claims. Moreover, since non-elected claim 13 depends from elected claim 12, and in turn from generic claim 10, examination of these claims should yield any pertinent art in respect to claim 13. In any event non-elected claim 13 would be subject to reinstatement upon allowance of claims 10 and/or 12.

For the foregoing reasons, Applicant respectfully submits the Species Restriction is improper and respectfully requests that it be withdrawn.

C. CONCLUSION.

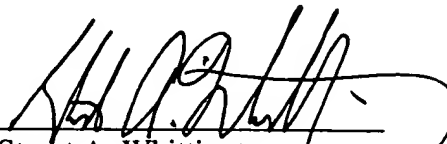
In response to the related invention restriction, Applicant elected claims 10-20 with traverse. In response to the species restriction Applicant elected claims 1-12 and 14-19 with traverse. If, however, both restriction requirements should be made final, and upon confirmation of any finality of these requirements by petition to the Commissioner, claims 10-12 and 13-19 would be the remaining elected claims to be examined fully on the merits.

Reconsideration and withdrawal of both requirements for restriction are respectfully requested. If there are any issues that may be resolved by a telephone call, the Examiner is kindly requested to contact the undersigned. Any fees, or deficiency thereof, required to

maintain the pendency of this application are hereby authorized to be charged to **Deposit Account No. 19-3878.**

Respectfully submitted,

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Date

By 
Stuart A. Whittington
Reg. No. 45,215

SQUIRE, SANDERS & DEMPSEY L.L.P.
Two Renaissance Square
40 North Central Avenue, Suite 2700
Phoenix, Arizona 85004-4498
(602) 528-4100
205287v2